

REMARKS

At the time of the Office Action dated March 18, 2004, claims 1 and 13-28 were pending. Of those claims, claims 1, 14-20 and 24-28 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Claims 13 and 21-23 stand rejected.

In this Amendment, claim 13 has been amended. Care has been exercised to avoid the introduction of new matter. Specifically, claim 13 has amended to include the limitation “the seal resin is positioned only between the second shade film of the second substrate and a transparent portion of the first substrate corresponding to the second shade film.” Adequate descriptive support for this amendment can be found on, for example, page 13, lines 20-24 of the specification.

Claims 13 and 21-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Prior Art (APA) in view of Morii.

In the statement of the rejection, the Examiner admitted that APA does not teach “first and second shading films formed between the outside edge portions of the first and second substrates to give peripheral shading.” Then, the Examiner asserted that Morii discloses the missing features and that Fig. 8 of Morii teaches “hardening the seal resin by irradiation to only one side of the substrate.” The Examiner's asserted motivation to combine APA and Morii is that “the use of such shading films yields advantages such as free from defects due to the adhesive sealant, high aperture ratio, high in reliability.” See paragraph 2 of the Office Action.

It is settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Based on this legal tenet, Applicants submit that the proposed combination of APA and Morii does not teach or suggest a manufacturing process of a liquid crystal display including all the limitations recited in independent claim 13, as amended. Specifically, the proposed combination does not teach or suggest the limitation “the seal resin is positioned only between the second shade film of the second substrate and a transparent portion of the first substrate corresponding to the second shade film” (emphasis added). The claimed invention defines a specific position where the seal resin is applied. In addition, by defining such a specific position for the seal resin, the claimed invention has an advantage of reducing a width of the seal resin and also reducing a width of an outside edge portion of the first and second substrates.

On the other hand, neither APA nor Morii teaches such a specific position where the seal resin is applied. APA does not teach, among other things, that a seal resin 4 is positioned between a second shade film and a transparent portion (see Figs. 18(a) and 18(b) of the present Application). As the Examiner admitted, in the first place, APA does not teach a second shade film recited of the claimed invention.

As shown in Fig. 8, Morii discloses filling adhesive sealant 108 with the whole space between an electrode substrates 105 and 110 (i.e., between the electrode substrate 110 and a light shielding film 104, and between light shielding films 104 and 107. Thus, Morii itself suggests that the reference does not explicitly or implicitly teach a specific position where adhesive sealant 108 is applied between the electrode substrates 105 and 110.

Accordingly, the proposed combination of APA and Morii does not teach or suggest a manufacturing process of a liquid crystal display including all the limitations recited in claim 13 and its advantage. *In re Royka*, 490 F.2d 981. Therefore, Applicants respectfully solicit withdrawal of the rejection of claim 13 and favorable consideration thereof.

It is also noted that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, as claim 13 is patentable for the reasons set forth above, it is submitted that dependent claims 21-23 which respectively depend from claim 13 are also patentable. Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 21-23 and favorable consideration thereof.

Conclusion.

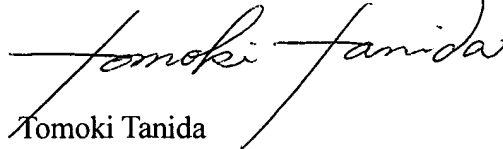
Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/881,753

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY-LLP

A handwritten signature in black ink, appearing to read "Tomoki Tanida", written over a horizontal line.

Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:TT:lnm
Facsimile: (202) 756-8087
Date: June 16, 2004